



### REMARKS

Claims 21 and 22 have been amended to correct dependencies, and claim 24 has been added. No new matter has been introduced by virtue of those new claims. For instance, support for the new claim appears in the examples of the application.

Claims 12-23 were rejected under 35 U.S.C. 112, first paragraph.

As grounds for the rejection, it is stated that the only working example of an A group is a particular group and "[t]herefore, a persons of skill in the art would deem that Applicant did not possess the entire invention as claimed at the time of the filing."

It is also stated that "the specification, while being enabling for treating some cancers, does not reasonably provide enablement for treating all cancers."

The rejection is traversed.

The present application fully satisfies the rejection of 35 U.S.C. 112, including the make and use requirements of Section 112, first paragraph.

For instance, compounds of Formula I are disclosed at pages 1 through 2 of the application, with detailed elaboration of those compounds set forth at 3 through 10 of the application. An extensive number of synthesis examples are also set forth in the application as filed.

Clearly based on such extensive disclosure as the present application, the skilled worker would have been able to make compounds of the invention.

Therapeutic uses of compounds of are detailed for instance at pages 9 through 12 of the application.

Moreover, no substantiating reasons have been advanced as to why one skilled in the art could not make and use the claimed invention. Indeed, the discussion above makes clear that one skilled in the art could readily practice the claimed invention in view of Applicants' disclosure.

Respectfully, such a rejection, lacking any supporting evidence or other substantiating grounds is simply not proper. Thus, for example, MPEP §2164.04 states the following (quoting *In re Marzocchi*, 169 USPQ 367):

[I]t is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

In view thereof, withdrawal of the rejection is requested.

Claims 12-23 were rejected under 35 U.S.C. 112, second paragraph. As grounds for the rejection, the following is stated at pages 6-7 of the Office Action:

In the claims, A, U, and R2 are defined to include the terms "heteroalkyl and heteroalkylcycloalkyl," which are defined in the specification to include an indefinite number of possible groups.

The rejection is traversed.

The skilled worker readily understands the terms "heteroalkyl and heteroalkylcycloalkyl," particularly when those terms are read in light of the supporting specification. In this regard, attention is directed to pages 4 and 5 of the application.

Respectfully, it appears that the requirements of a disclosure are confused in the Office Action with what Section 112, second paragraph requires for claim language. In this regard, attention is directed to *In re Rainer*, 134 USPQ at 346 (copy previously submitted), which states in part:

One does not look to claims to find out how to *practice* the inventions they define, but to the specification.

Attention is further directed to the Manual of Patent Examining Procedure at Sections 2173.02 and 2173.04:

When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow the claims which define the patentable subject with a reasonable degree of particularity and definiteness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.

\* \* \*

Breadth of a claim is not to be equated with indefiniteness.

In view thereof, reconsideration and withdrawal of the rejection are requested.

Claims 12-21 were rejected under 35 U.S.C. 102 (e) over Hoeffle et al. (WO/2004/007493).

To expedite prosecution, Applicants will submit an English language translation of the German priority applications of the present case.

Claims 12-23 were rejected under 35 U.S.C. 103 over Nicolaou et al. (Angew Chem. Int. Ed. 1998, 2014-2045) in view of Patani et al. (Chem. Rev. 1996, 3176).

In the Office Action, it is acknowledged that "Niocolau et al. do not teach a thioether or a SO<sub>2</sub> in place of the carbonyl next to the gem-dimethyl of the epothilone ring."

Nevertheless, the position is taken that Patani reports “that carbonyl can be replaced by S, SO, SO<sub>2</sub> if the position is not essential to the function of the molecule.”

The rejection is traversed.

Patani is merely a background article and provides no motivation sufficient to sustain the instant Section 103 rejection to modify the Nicolaou et al. document as has been proposed.

Indeed, the structural distinction between Applicants’ claimed compounds and the compounds of the Nicolaou et al. document (such distinctions specifically acknowledged in the Office Action) makes clear that a *prima facie* case under Section 103 does not exist here.

For example, in *In re Grabiak*, 226 USPQ 872, the Court of Appeals for the Federal Circuit reversed a rejection under Section 103 on the basis that the cited document provided no suggestion to replace oxygen (in the ester of the cited document) with sulfur (to provide the thioester of the claimed compound). The Federal Circuit particularly noted (page 872):

The PTO cited no pertinent reference showing or suggesting to one of ordinary skill in the art the change of the thioester for an ester group. In the absence of such reference, there is inadequate support for the PTO's position that this modification would *prima facie* have been obvious.

In view thereof, reconsideration and withdrawal of the rejection is requested.

Claims 12-23 were provisionally rejected on grounds of obviousness-type double patenting over certain claims of U.S. application no. 10/520769 in view of Patani et al. The rejection is traversed.

As discussed above, Patani et al. is merely a background document and provides no suggestion to modify the cited copending application claims in a manner sufficient to sustain the instant rejection.

W. Richter et al.

USSN: 10/535,474

Page 10



Accordingly, withdrawal of the rejection is requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to be "P. Corless", written over a horizontal line.

Peter F. Corless

Registration No. 33,860

EDWARDS ANGELL PALMER & DODGE LLP

P.O. Box 55874

Boston, Massachusetts 02205

Tel. No. (617) 517-5564

Customer No. 21,874